

## **REMARKS**

### ***Status of the Claims***

The pending Office Action addresses and rejects claims 1-6, 8, 10-18, and 27-55. Reconsideration is respectfully requested based on the remarks herein.

Applicant thanks the Examiner for the telephone interview with Applicant's undersigned representative on October 5, 2009.

### ***Amendments to the Claims***

Independent claim 1 is amended to recite that the pathways have central *longitudinal* axes that are substantially parallel to at least a portion of a front surface of the distal portion of the elongate member. Independent claim 31 is amended to recite that the at least one pathway has a central *longitudinal* axis that extends in a proximal-distal direction *and that is substantially parallel to a plane containing the front sidewall of the guide member, the plane of the front sidewall extending in a proximal-distal direction*. Independent claim 40 is amended to recite that the first and second pathways have central *longitudinal* axes that extend substantially parallel to at least a portion of the distal, tissue-retracting portion of the elongate member *and that do not intersect any portion of the elongate member*. Support for these amendments can be found throughout the specification and drawings, for example in Figures 5A and 5B. No new matter is added.

### ***Rejections Pursuant to 35 U.S.C. § 102***

Claims 1-6, 8, 10-18, 27, 28, 31-36, and 40-55 are rejected pursuant to 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,558,622 of Greenberg ("Greenberg"). Applicant respectfully disagrees.

In relevant part, independent claim 1 recites that the pathways have central longitudinal axes that are substantially parallel to at least a portion of a front surface of the distal portion of the elongate member, independent claim 31 recites that the at least one pathway has a central longitudinal axis that extends in a proximal-distal direction and that is substantially parallel to a plane containing the front sidewall of the guide member, the plane of the front sidewall extending in

a proximal-distal direction, and independent claim 40 recites that the first and second pathways have central longitudinal axes that extend substantially parallel to at least a portion of the distal, tissue-retracting portion of the elongate member and that do not intersect any portion of the elongate member.

The Examiner agreed in the October 5, 2009 interview that Greenberg fails to disclose at least the central longitudinal axes recited in claims 1, 31, and 40. Applicant notes that none of the axes drawn by the Examiner in the annotated versions of Figures 27B and 28 on pages 3 and 5 of the Office Action are central *longitudinal* axes.

Accordingly, independent claims 1, 31, and 40, as well as claims 2-6, 8, 10-18, 27, 28, 32-36, and 41-55 which variously depend therefrom, distinguish over Greenberg and represent allowable subject matter.

### ***Rejections Pursuant to 35 U.S.C. § 103***

Claims 29, 30, and 37-39 are rejected pursuant to 35 U.S.C. §103(a) as being obvious over Greenberg. Applicant respectfully disagrees.

#### **Claims 29 and 30**

At least for the reasons explained above, independent claim 1 distinguishes over Greenberg. Accordingly, claims 29 and 30, which depend from claim 1, are allowable at least because they depend from an allowable base claim.

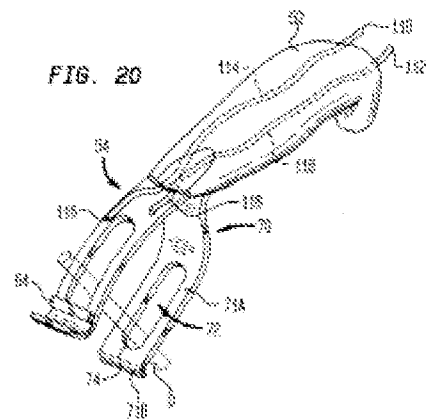
#### **Claims 37-39**

In the October 5, 2009 interview the Examiner encouraged Applicant to present written arguments regarding claim 37. In relevant part, independent claim 37 recites a cross member removably and reattachably connected to the first and second tissue retractor and guide devices. Greenberg fails to disclose the claimed invention for at least two reasons.

Greenberg fails to disclose first and second tissue retractor and guide devices

Applicant cannot find a cross member removably and reattachably connected to first and second tissue retractor and guide devices in Greenberg. The Examiner does not particularly identify such a cross member in Greenberg but generally refers to a “handle” on page 4 of the Office Action in the rejection of claims 29, 30, and 37-39.

Figure 20 of Greenberg, reproduced below, illustrates a handle 52 having a retracting blade 54 and a stabilizing arm 70 extending therefrom. However, the stabilizing arm 70 is not a retractor and guide device as recited in claim 37. The stabilizing arm 70 is present merely to stabilize a surgical instrument D inserted through the retractor blade’s distal aperture and does not get inserted into a patient’s body. *See* Greenberg, col. 6, lines 56-65. As such, the stabilizing arm 70 at least does not have the claimed elongate member having a tissue-retracting portion, much less the claimed guide member having the recited sidewalls. Thus, Greenberg fails to disclose the claimed invention for at least this independent reason.



A person skilled in the art would not modify Greenberg as suggested by the Examiner

Even if the retracting blade 54 and the stabilizing arm 70 are considered tissue retractor and guide devices despite them each missing multiple recited claim elements, there is absolutely no indication in Greenberg that the handle 52 is or could be removable and reattachable, much less connectable to two tissue retractor and guide devices. The Examiner argues on page 4 of the Office Action that it “would have been obvious to have made the cross member (handle) removable and reattachable, for example to facilitate cleaning or storage,” but that ignores the actual design, construction, and function of the device including the handle 52. As clearly shown in Figure 20, a suction fitting input 110 and a fiber optic input 112 each extend from outside the handle 52, through the handle 52, and down the retractor blade 54. Removing and reattaching the handle 52 as suggested by the Examiner is not a simple reattachment and replacement but a careful, potentially impossible, dismantling of the device to accommodate the suction fitting input 110 and the fiber

optic input 112.

Moreover, the Examiner's reliance on *Nerwin v. Erlichman*, 168 USPQ 177, 179 (1969) on page 4 of the Office Action is inappropriate and does not support the Examiner's position. The Examiner relies on *Nerwin* for the proposition that "it has been held that constructing a formerly integral structure in various elements only involves routine skill in the art." Office Action, p. 4. However, in the present case there is no issue of Greenberg disclosing an integral structure that the claimed invention requires be composed of "various elements." Instead, Greenberg discloses a handle 52, and the Examiner is likening the handle 52 to the cross member required by claim 37. Neither Applicant nor the Examiner is suggesting that the single handle 52 of Greenberg be divided into several elements to meet various recitations of the claim. Rather, the Examiner is apparently likening the handle 52 as a whole to the cross member of claim 37 and is proposing an entire reconstruction and redesign of Greenberg in which the handle 52 is somehow made removable and reattachable from the retractor blade 54 and the stabilizing arm 70 while somehow accommodating the suction fitting input 110 and the fiber optic input 112 that run through the handle 52 and down the retractor blade 54. The issue is thus not mere construction of a formerly integral structure into multiple elements, as was at issue in *Nerwin*, but rather a substantial reconstruction and redesign of Greenberg. A person skilled in the art would simply not make the modification proposed by the Examiner at least because it would entail an impermissible substantial reconstruction and redesign of the device to not only account for all the various interconnected elements of the device but to also maintain the device's functionality before and after removing and reattaching the handle 52. MPEP 2143.01.

In contrast, the claimed cross member can, as shown for example in Figures 7 and 8 of the present application, allow two tissue retractor and guide devices to be connected together and mate to a single spinal plate. In this way, a surgeon can efficiently prepare the vertebrae and implant the plate, and desirable tissue retractor and guide devices can be selected and/or interchanged for a particular surgical application. See Application, para. [0049] and [0050].

Accordingly, independent claim 37, as well as claims 38 and 39 which variously depend therefrom, distinguish over Greenberg and represent allowable subject matter.

***Conclusion***

Accordingly, all claims are now in condition for allowance, and allowance thereof is respectfully requested. Applicants' amendment of the claims does not constitute a concession that the claims are not allowable in their unamended form. The Examiner is encouraged to telephone the undersigned attorney for Applicants if such communication is deemed to expedite prosecution of this application.

No extension of time is believed to be due with this filing. In the event that a petition for an extension of time is required to be submitted at this time, Applicants hereby petition under 37 C.F.R. 1.136(a) for an extension of time for as many months as are required to ensure that the above-identified application does not become abandoned.

All fees due are believed to be paid. The Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 141449, under Order No. 101896-234.

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Respectfully submitted,

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